

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	:	
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B. Shankar <i>et al</i>	:	Examiner: Z. N. Davis
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Application No.: 10/803,577	:	Group Art Unit: 1625
	:	
Filed: 03/18/2004	:	Date: May 22, 2009
	:	
For: "Cannabinoid Receptor Ligands"	:	
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Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

This communication is in response to the Office Action issued on May 13, 2009, in the subject case.

Claims 16, 17, 21-23, 30-31, 58-91, and 94-96 are pending in the case. The Examiner restricted the invention into five (V) groups:

Group I: Claims 16-17, 21-23, 30-31, 64-65, 70-73, 76-77, 82-85, 88-91, 94, and 95, drawn to a chemical compound, a pharmaceutical composition and process to make the claimed compounds;

Group II: Claims 58-61 and 96, drawn to a method for treating cancer using at least one chemical compound of claim 16, claim 17, or claim 21;

Group III: Claims 58-63, 66-69, and 96, drawn to a method for treating inflammatory diseases using at least one chemical compound of claim 16, 17, or 21;

Group IV: Claims 58-63, 74-75, 78-81, and 96, drawn to a method for treating immunomodulatory diseases using at least one chemical compound of claim 16, 17, or 21;

Group V: Claims 58-6, 86, 87, and 96, drawn to a method for treating respiratory diseases using at least one chemical compound of claim 16, 17, or 21.

No species election was required.

Applicants are puzzled as to why another restriction requirement was issued, especially in view of the previous restriction requirement which was already issued by the Examiner.

Moreover, Applicants believe that all pending claims form part of one and the same invention. Applicants further believe that when there is a linking claim (claim 1 here) encompassing the scope of all the processes, uses, composition and compounds, it is inappropriate to restrict the invention into these various inventions. Applicants also believe that due to such commonality, a complete examination of all of the pending claims would not cause undue burden. Applicants further believe that the same art search will most probably apply to the alleged separate inventions, and respectfully submit that the restriction is improper.

Under the statute "two or more independent and distinct inventions.... in one application may.... be restricted to one of the inventions." Inventions are "independent" if "there is no disclosed relationship between two or more subjects disclosed" (MPEP 802.01). The term "distinct" means that "two or more subjects as disclosed are related.... but are capable of separate manufacture, use or sale as claimed, and are patentable over each other" (MPEP 802.01). However, even when patentably distinct inventions, restriction is not required unless one of the following reasons appear (MPEP 808.02):

1. Separate classification
2. Separate status in the art; or
3. Different field of search.

In the present application, Applicant believes that the Examiner has not established a clear reason to establish the existence of any of the above 3 groups. Reconsideration and withdrawal of the restriction requirement are, therefore, respectfully requested.

However, in the interest of advancing the prosecution, Applicants elect, with traverse, the invention cited as Group I for prosecution on the merits.

Applicants note with appreciation that the Examiner has indicated the possibility of rejoinder of method claims that depend from or otherwise include all the limitations of the patentable product as a matter of right.

If the Examiner has questions, she is invited to contact the undersigned.

May 22, 2009
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Respectfully submitted,



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